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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/541,391	03/31/2000	Rick Dedrick	042390.P7954	3488

7590

04/22/2003

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EXAMINER

ABDI, KAMBIZ

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

81

Office Action Summary

Application No.

09/541,391

Applicant(s)

DEDRICK ET AL.

Examiner

Kambiz Abdi

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14, 16-22, and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3621

DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and responses to previously presented claims and arguments.

2. Claims 1-6, 8-14, 16-22, and 24 have been examined.

Claims 7, 15, and 23 canceled.

Claims 1, 8, 10, 16, and 17 have been amended.

Claims 1-6, 8-14, 16-22, and 24 have been considered

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-14, 16-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,189,146 to Pradyumna K. Misra in view of 5892900 to Karl L. Ginter, and 6,269,343 to Matthew G. Pallakoff.

5. As for claims 1-6, 8-14, 16-22, and 24, Misra discloses an apparatus comprising;

- Claims 1, 10, 17; a repository for storing a volume license agreement (See Misra column 6, lines 50-68 and column 7, lines 1-11);
- Claims 1, 10; a repository for maintaining a purchase history (See Misra tables 3 and 4, column 9, lines 29-61, and column 4, lines 15-30);
- Claims 1, 10; a purchase generator (See Misra figures 3 and 4, column 2, lines 32-61).

Art Unit: 3621

- Claim 2; a clearinghouse, the clearinghouse being remotely connected to the pricing generator over a communications network (See Misra figures 1 and 3, column 3, lines 59-68, and column 4, lines 1-13).
- Claims 24, 3; the communications network is the Internet (See Misra column 4, lines 1-21).
- Claim 4; the clearinghouse is further remotely connected to at least one of a plurality of publishers, the publishers periodically transmitting a new volume licensing agreement to the clearinghouse (See Misra column 2, lines 47-68).
- Claim 5; the clearinghouse is further remotely connected to at least one of a plurality of distributors, the distributors periodically transmitting a new volume licensing agreement to the clearinghouse (See Misra column 2, lines 47-68).
- Claim 6, 20; purchase history is updated to reflect the transacted purchase (See Misra tables 3 and 4, column 4, lines 15-30, and column 9, lines 29-61).
- Claim 9; an electronic distribution mechanism to automatically install the purchased product (See Misra column 6, lines 20-45 and column 8, lines 35-52).
- Claim 13; include instructions to extract the volume license agreement from a remote clearinghouse (See Misra column 4, lines 49-68).
- Claim 14; storing instructions further include extracting updated information about the products license under the volume licensing agreement (See Misra column 11, lines 25-45 and column 15, lines 19-36).
- Claim 19; recording a history of purchases includes recording a point value associated with the purchase in accordance with the volume license agreement (See Misra column 2, lines 22-47 and column 4, lines 1-42).

Misra fails to teach the following features which are thought by Pallakoff and Ginter.

- Claim 1; a pricing generator to generate a purchase price for the product in accordance with the volume license agreement and the purchase history (See Pallakoff column 7, lines 15-59 and Ginter column 22, lines 26-68, column 23, lines 1-44, column 24, lines 9-68, and column 25, lines 1-35).

Art Unit: 3621

- a rules engine containing a set of rules for determining a discount step for the product in accordance with the volume licensing agreement (See Pallakoff column 7, lines 15-59 and Ginter column 22, lines 26-68, column 23, lines 1-44, column 24, lines 9-68, and column 25, lines 1-35).
 - Claims 8, 16, 21; the rules engine further contains a set of rules for determining a discount step for the product in accordance with a profile of the user (See Pallakoff column 7, lines 15-59 or Ginter column 22, lines 26-68, column 23, lines 1-44, column 24, lines 9-68, and column 25, lines 1-35).
 - Claim 1; the purchase price is generated in response to a purchaser request (See Pallakoff column 7, lines 30-59 or Ginter column 22, lines 26-68, column 23, lines 1-44, column 24, lines 9-68, and column 25, lines 1-35).
 - Claims 11, 12; communicating the purchase price to the user in a visual display (See Pallakoff column 4, lines 42-63 or Ginter column 22, lines 26-68, column 23, lines 1-44, column 24, lines 9-68, and column 25, lines 1-35).
 - Claims 18, 22; communicating the approval by the user to purchase in a response to the visual display (See Pallakoff column 7, lines 5-30 or Ginter column 22, lines 26-68, column 23, lines 1-44, column 24, lines 9-68, and column 25, lines 1-35).
6. Furthermore, Misra is not explicit on a pricing method of the digital content as is licensed, distributed and managed through its system. Even though Misra discloses the collection of purchase history but Misra is not clear about the purpose of this data being used for eventual pricing of the digital content to be delivered through the system. However, both Pallakoff and Ginter clearly teach a pricing generator. Ginter clearly teaches the usage of all types of information (Historical, time period purchasing, limit purchasing, and many other metering activities) collected by the licensing system in order to calculate a price for the further licensing of data to be paid by the end user. Collected information is used as a determinant tool to calculate discounts for an agreed upon levels of discount in the license agreement. Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the above teaching to create a more accurate and efficient

Art Unit: 3621

system to track licensing digital content and make available further obtaining of digital content in amore favorable discounted rates based on the volume purchasing history.

7. A volume discount can be set as a pre-determinant criterion of discounting in addition to or separate from the historical purchasing of the end user activities base on a license agreement (See applicants discloser page 2, paragraph 3 and page 3, paragraph 1 and 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have added a well-known practice of volume discount pricing method in conjunction with a past purchasing history to calculate a discount level, to a license management system such as Misra's. Since it has been held that broadly providing a mechanical or automatic means to replace manual activity such as calculating prices, discounts or such, which has accomplished the same result, involves only routine skill in the art. In re Vernner, 120 USPQ 192. This combination would have been obvious to one of ordinary skill in the art for greater efficiency and economy in the management of licensing and pricing of volume discounted goods or services.

Response to Arguments

8. Applicant's arguments filed on 5 February 2003 have been fully considered but they are not persuasive.

9. The applicant has put forward the argument that claim 1 recites the "determining a discount step for the product in accordance with the volume licensing agreement..." With respect to the argument examiner disagrees with applicant. It is admitted by the applicant the historical practice of volume discounting, in addition to that, Ginter clearly teaches the volume discount by taking to consideration of volume of purchase and the historical data on the volume purchases made by the single entity (See Ginter column 22, lines 48-52). Ginter clearly teaches the step discounts (Ginter "...might be discounted by 15%..." as well. The argument put forward by the applicant regarding the updating the purchase price is self evidence based on the argument that has been made above and the examiner disagrees with the applicant. Misra clearly introduces the fact the there is a clearinghouse in order to make purchases of volume licenses and their control. In addition Ginter and Pallakoff clearly teach volume discounting based on historical purchase (See Misra column 6, lines 50-64).

Art Unit: 3621

10. On the subject of displaying a purchase price and consummating the transaction, it has been admitted by the applicant that this practice has been done manually and now it is automated (See application specification page 3, paragraph 2, lines 3-11). Examiner respectfully disagrees with the applicant, according to the specification and disclosure of the fact that practice of volume discount is a prevalent practice within the art and it has been done manually. Additionally it is well known practice once a customer has requested a "Request For Purchase" (RFP) a sales person would have to provide a end user or purchaser with a written proposal that would have a multiple terms and conditions in addition to a discount level (Step) and price. This traditionally has been provided in a document form. This document would have displayed the purchase price and by agreeing to the price a transaction would be consummated. Therefore, it is clear that the manual activity could be made automated that would achieve the same results. Since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Vernner, 120 USPQ 192. This combination would have been obvious to one of ordinary skill in the art for greater efficiency and economy in the management of licensing and pricing of volume discounted goods or services.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3621

Utility of volume discount and progressive lowering of the price of goods or services is a well known within the art. The use of this method of bulk buying and volume discount is a known practice and has been anticipated. To utilize this method in an automated manner does not render it patentable.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to:

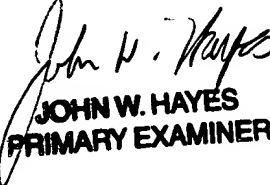
(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

Abdi/K
21 April 2003


**JOHN W. HAYES
PRIMARY EXAMINER**